



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/681,751	11/20/2012	Chris Bancel	45NK-218456	9905

133759 7590 03/09/2017
Sheppard Mullin Richter & Hampton LLP
12275 El Camino Real, Suite 200
San Diego, CA 92130

EXAMINER

PIERCE, WILLIAM M

ART UNIT	PAPER NUMBER
----------	--------------

3711

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

03/09/2017

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

dmipdocketing@sheppardmullin.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHRIS BANCEL, RICH ALLEN,
and JONATHAN AVERY

Appeal 2016-005064
Application 13/681,751
Technology Center 3700

Before JILL D. HILL, JAMES J. MAYBERRY, and SEAN P. O'HANLON,
Administrative Patent Judges.

HILL, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Chris Bancel et al. (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's non-final decision rejecting claims 32–59 and 63.

Appellants' representative presented oral argument on February 23, 2017.

We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

BACKGROUND

Independent claims 32 and 41 are pending. Independent claim 32, reproduced below, illustrates the claimed invention.

32. A method implemented in a data processing system having a programmed computer for enabling a plurality of players to compete, over a plurality of time-limited rounds of a gameplay session, in a puzzle-based game comprising a plurality of puzzle components each comprising a plurality of puzzle elements, each puzzle component having a respective predefined solution, the method comprising:

- providing, by the data processing system, at least one puzzle component to each player, wherein at least one first puzzle component provided to a first player playing against a second player comprises a plurality of puzzle elements that are common to at least one second puzzle component provided to the second player;

- enabling, by the data processing system, each player to place a wager during at least one round;

- enabling, by the data processing system, each player to interact with their corresponding at least one puzzle component to select a particular at least one corresponding predefined solution determination path and to progress toward determination of the corresponding predefined solution by solving at least a portion of said plurality of puzzle elements;

- determining, by the data processing system in accordance with the at least one predefined scoring rule, for each round, a puzzle solution score for each player that placed a wager during said at least one round; and

- determining, by the data processing system at a conclusion of a last round of the gameplay session, a total session score for each player based on the puzzle solution score for each round.

REJECTIONS

Claims 32–59 and 63 stand rejected on the ground of non-statutory double patenting. Non-Final Act. 4.

Claims 32–59 and 63 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Non-Final Act. 4.

Claims 32–59 and 63 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Samberg (US 6,572,111 B1; iss. June 3, 2003) and GameColony.com. Non-Final Act. 14.

OPINION

Double Patenting

Appellants do not refute the double patenting rejection in the Appeal Brief. Appeal Br. 2 n.1. We therefore summarily sustain the double patenting rejection.

Prior Art

The Examiner finds that Samberg discloses, *inter alia*, puzzle components for a first player that are common to puzzle components for at least a second player. Non-Final Act. 14. The Examiner finds that Samberg’s Gin Rummy hand is such a puzzle component. *Id.* The Examiner further finds that the hands are “common” because the Gin Rummy hands are “identical.” *Id.* at 16.

Appellants argue that the Examiner’s finding is in error, because Gin Rummy hands are not puzzle components with common elements. Appeal Br. 20. According to Appellants, a first player playing against a second player in Samberg “is not provided with a plurality of cards that are common with cards provided to the [second] player,” because the first and second players are dealt cards from the same deck such that they “necessarily cannot share cards in common.” *Id.* (emphasis omitted).

The Examiner responds that the term “common” is being construed to mean the same, and therefore “[t]he mere fact that both players are given cards is enough [] to describe both the first and second puzzle components as ‘common.’” Ans. 9. The Examiner considers all playing cards to be “common.” *Id.*

We agree with Appellants that the Examiner’s finding is in error. Appellants’ Specification defines the term “puzzle” as “‘a question, problem or contrivance,’” and lists a number of exemplary puzzles that differ from card games. Spec 4–5. Given Appellants’ definition of the term “puzzle,” and use of the term in Appellants’ Specification, we are not persuaded that a hand of Gin Rummy is a puzzle component. The Examiner has not explained how a hand of playing cards can be considered a question, problem, or contrivance.

We therefore do not sustain the rejection of the claims as unpatentable over Samberg and GameColony.com.

Non-Statutory Subject Matter

The Examiner determines that the pending claims are “directed to nothing more than an abstract idea in the rules for playing a game.” Non-Final Act 6. The Examiner additionally determines that: (1) there is no sufficient transformation under the machine-or-transformation test “as the [puzzles] and players remain the same after performing the steps in the claimed invention;” and (2) the claimed “data processing system” is not a particular apparatus because the game can be played without the use of the data processing system. *Id.*

Appellants argue that their claims recite patent-eligible subject matter because they recite additionally elements beyond an abstract idea and, in

accordance with the machine-or-transformation test, they are “tied to a particular machine or apparatus” and “recite transformation of a particular article into a different state or thing.” Appeal Br. 7.

Identification of the Abstract Idea

In *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347 (2014), the Supreme Court set forth an analytical “framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1296-97 (2012)). The first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” such as an abstract idea. *Id.*

Appellants argue that the Examiner failed to identify an abstract idea that is recited by the claims. Appeal Br. 14–15. The Examiner responds that the abstract idea was identified as rules for playing a game. Ans. 7.

If the claims are directed to a patent-ineligible concept, the second step in the analysis is to consider the elements of the claims “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 132 S. Ct. at 1298). In other words, the second step is to “search for an ‘inventive concept’—i.e., an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Id.* (brackets in original) (quoting *Mayo*, 132 S. Ct. at 1294).

Turning to the first step of the *Alice* inquiry, we agree with the Examiner that the pending claims are directed to a patent-ineligible abstract concept of rules for playing a game. Ans. 7. The steps recited in Appellants' claims, including providing a puzzle, enabling a wager, enabling interaction with the puzzle, and determining a score, are abstract processes of displaying, collecting, and analyzing information of a specific content. Information as such is an intangible. See *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437, 451 n.12 (2007). Information display, collection, and analysis, even when limited to particular content, is within the realm of abstract ideas. See, e.g., *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1349 (Fed. Cir. 2015); *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014); and *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011).

As recognized by the Federal Circuit in *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715–16 (Fed. Cir. 2014), *Bilski*'s machine-or-transformation test can provide a useful clue in the second step of the *Alice* framework. Under the machine-or-transformation test, a claimed process is patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus; or (2) it transforms a particular article into a different state or thing. See *Bilski*, 545 F.3d 943, 954 (Fed. Cir. 2008).

Particular Apparatus

Regarding the machine-or-transformation test, Appellants contend that the Examiner erred in requiring that a “particular apparatus” under the machine-or-transformation test be essential to playing the game, and that the claimed data processing system is essential to play of the claimed game. Appeal Br. 8. According to Appellants, *Bilski* held that an apparatus

satisfies the machine-or-transformation test when “(1) use of the data processing system imposes meaningful limits on the claim’s scope, and (2) the involvement of the data processing system in the claimed process is not merely insignificant extra-solution activity.” *Id.* (citing *In re Bilski*, 545 F.3d at 966). Appellants appear to allege that the recited data processing system imposes meaningful limits on the claims’ scope because it is recited in each of the method steps of the claim, such that the steps of the claimed method are performed by the data processing system. *Id.* at 9. Appellants further contend that involvement of the data processing system “is not merely insignificant extra-solution activity,” and that the claimed invention “is not merely a game played on a data processing system,” because (1) the claimed data processing system “is related to” software programs executed thereon (e.g., multi-player software gaming applications), (2) can include “mobile phones, personal computers, etc.,” and (3) can be integrated into various social networking platforms. *Id.* at 10 (citing Spec. 15, 16).

Appellants further contend that the claimed data processing system is a particular machine because “a generic computer programmed with specific programming instructions transforms the generic computer into a special purpose computer.” Appeal Br. 15–16 (citing *In re Alappat*, 33 F.3d 1526, 1543 (Fed. Cir. 1994)); Reply Br. 2.

The Examiner disagrees, arguing that Appellants have not explained how the data processing system, recited throughout the claims, is essential to play of the game. Ans. 2–4 (citing *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 716–17 (Fed. Cir. 2014)).

The Examiner has the better argument. Limiting the abstract concept of rules and steps for playing a game to implementation on a known data

processing system does not make the abstract concept patent-eligible under 35 U.S.C. § 101. As recognized by the Supreme Court, “the mere recitation of a generic computer cannot transform a patent ineligible abstract idea into a patent-eligible invention.” *See Alice*, 134 S. Ct. at 2358 (concluding claims “simply instruct[ing] the practitioner to implement the abstract idea of intermediated settlement on a generic computer” not patent eligible); *see also Ultramercial*, 772 F.3d at 715–16 (providing that claims merely reciting abstract idea of using advertising as currency as applied to particular technological environment of the Internet not patent eligible); and *Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1344–45 (Fed. Cir. 2013) (providing that claims reciting “generalized software components arranged to [generate insurance-policy-related tasks based on rules to be completed upon the occurrence of an event] on a computer” is not patent eligible).

Transformation

Appellants also argue that the claimed invention involves a transformation of data because the puzzle component(s) that are provided by the data processing system are “modified (by the data processing system) based on player interaction with the puzzle component.” Appeal Br. 11. Appellants further contend that this the transformation of data “is not merely insignificant extra-solution activity . . . because the claimed invention relates to allowing a player to interact with his puzzle component in order to progress toward completion of a solution to compete with other players and win associated wagers.” *Id.* at 12; Reply Br. 3.

The Examiner disagrees, arguing that the alleged transformation of data is not a sufficient transformation, because nothing changes to a different

state or derives new capabilities. Ans. 4–5 (“there is merely a change in location or of indicia and any meaning afforded to the indicia is dictated by the rules themselves”).

The Examiner again has the better argument. The Federal Circuit has held that the following do not satisfy the transformation prong of the machine-or-transformation test: (1) collection and organization of data; and (2) manipulation or reorganization of data. *See CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d at 1371, 1375. The court concluded that collecting, organizing, and manipulating data did not satisfy the transformation prong because each action could be performed in the human mind. *See id.* at 1373, 1376–77. Appellants’ own Specification discloses that the claimed providing, enabling, and determining steps need not be performed by a data processing system. *See, e.g.*, Spec. 28–35 (describing “Exemplary Embodiment #1”). Although a data processing system may enhance the claimed method, for example with displays or increased processing speed, each of the steps can nonetheless be performed by a dealer and the players.

Thus, considering the second step of the *Alice* inquiry, we agree with the Examiner that nothing in claims adds “significantly more” to transform the abstract concept of displaying, collecting, storing, and analyzing information into a patent-eligible application. *See Alice*, 134 S. Ct. at 2357. Rather, the claims simply incorporate a known data processing system to perform the abstract concept of applying rules and performing steps for playing a game, i.e., displaying, collecting, storing, and analyzing information.

Preemption

Appellants next argue that the claimed invention is directed to statutory subject matter because the claims do not preempt an abstract idea or tie up all action between participants in playing a game. Appeal Br. 6, 12 (citing *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. at 2351–52); Reply Br. 3.

We are not persuaded by this argument. Although *Alice* was indeed concerned with preemption, the Federal Circuit has stated that “[w]hile preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility. . . . Where a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, . . . preemption concerns are fully addressed and made moot.” *Ariosa Diagnostics Inc. v. Sequenom Inc.*, 788 F.3d 1371, 1376 (Fed. Cir. 2015). Thus, based on our analysis above, this argument is rendered moot.

Dependent Claims

Appellants argue that the dependent claims were improperly rejected without individually addressing their claimed features. Appeal Br. 17. The Examiner contends that, to the contrary, “the examiner’s position is directed to all the claims as being patent ineligible and that none of any features of any of the claims overcome that position.” Ans. 8. Appellants contend, in response, that a prima facie case must be establish for each claim independently. Reply Br. 3–4.

We are not persuaded that the Examiner failed to establish prima facie obviousness of the dependent claims. The Examiner stated that the claimed method steps, generally, are directed to the abstract idea of rules and steps

for playing a game. Each of the dependent claims recite rules and steps for playing a game. We decline to find error in the Examiner's decision not to (1) recite each depended claim limitation separately, (2) state that the limitation recites rules and steps for playing a game, and then (3) state that recited rules and steps for playing a game are an abstract idea.

Conclusion

For the reasons set above, we sustain the rejection of the claims under 35 U.S.C. § 101 as directed to non-statutory subject matter.

DECISION

We AFFIRM the rejection of claims 32–59 and 63 on the ground of non-statutory double patenting.

We AFFIRM the rejection of claims 32–59 and 63 under 35 U.S.C. § 101 as directed to non-statutory subject matter.

We REVERSE the rejection of claim 32–59 and 63 under 32 U.S.C. § 103(a) as unpatentable over Samberg and GameColony.com

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED